

8/9/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 30
TJQ/ajb

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Crazy Shirts, Inc.

v.

J. B. Heise

Opposition No. 101,033
to application Serial No. 74/421,665
filed on August 9, 1993

Elise Owens Thorn of Edmunds Maki Verga & Thorn for **Crazy Shirts, Inc.**

J. B. Heise, pro se.

Before **Seeherman, Quinn and Rogers,**
Administrative Trademark Judges.

Opinion by **Quinn,** Administrative Trademark Judge:

An application has been filed by J. B. Heise, an individual, to register the mark CRAZY THREADS for "embroidered clothing, namely shirts, pants, skirts, dresses, socks, hats and jackets" (International Class

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25), and for "embroidering services" (International Class 40).¹

Registration has been opposed by Crazy Shirts, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to his goods and services, so resembles opposer's previously used and registered marks CRAZY SHIRTS (stylized), for "silk screening t-shirts"²; CRAZY SHIRTS, for "wearing apparel - namely, t-shirts"³; CRAZY SHIRTS, for "retail clothing store services"⁴; CRAZYSHORTS, for "men's, women's and children's shorts"⁵; and CRAZYSWEATS (stylized), for "men's and women's sportswear; namely, men's and women's tops and bottoms"⁶ as to be likely to cause confusion.

Applicant, in his answer, denied the salient allegations of the opposition.

¹ Application Serial No. 74/421,665, filed August 9, 1993, claiming, in both classes, first use anywhere on June 10, 1993 and first use in commerce on July 7, 1993. The word "threads" has been disclaimed.

² Registration No. 943,290, issued September 19, 1972; amended August 7, 1973 and June 16, 1992; renewed. The term "shirts" has been disclaimed.

³ Registration No. 1,139,644, issued September 16, 1980; renewed. The term "shirts" has been disclaimed.

⁴ Registration No. 1,126,473, issued October 30, 1979; renewed. The term "shirts" has been disclaimed.

⁵ Registration No. 1,406,812, issued August 26, 1986; combined Sections 8 & 15 affidavit filed.

⁶ Registration No. 1,660,884, issued October 15, 1991; combined Sections 8 & 15 affidavit filed.

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The record consists of the pleadings; the file of the involved application; and trial testimony taken by opposer of opposer's founder and Chairman of the Board, Frederick Carleton Ralston, with related exhibits. Applicant did not take any testimony or introduce any evidence. Opposer filed a brief, and applicant responded with a two-page brief.

Opposer is engaged in the design and sale of clothing items, and Mr. Ralston testified that opposer's use of the mark CRAZY SHIRTS has been continuous since 1966. Opposer's clothing is sold through opposer's retail stores, opposer's mail order catalogs and the Internet. Opposer's most recent figures show annual sales under the mark at \$45 million, with annual promotional expenditures exceeding \$2.1 million.

Although opposer introduced excerpts from applicant's web page, there is no other evidence of record regarding applicant's business activities under his mark.

In view of opposer's ownership of valid and subsisting registrations for its pleaded marks, submitted as part of Mr. Ralston's deposition, there is no issue with respect to opposer's priority. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108

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(CCPA 1974). Moreover, the evidence shows that opposer has used the mark CRAZY SHIRTS since long prior to the filing date of applicant's application, which, in the absence of evidence of use, is the earliest date on which applicant may rely.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a comparison of the parties' goods and services, we note that opposer's pleaded registrations cover "silk screening t-shirts"⁷; t-shirts; men's, women's and children's shorts; men's and women's sportswear tops and bottoms; and retail clothing store services. The testimony of opposer's president and the

⁷ Despite the wording "silk screening t-shirts" in Registration No. 943,290, the registration clearly specifies that it covers clothing in International Class 25, and not silk screening services.

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catalogs submitted as exhibits show that opposer uses the mark CRAZY SHIRTS on or in connection with, among other clothing articles, t-shirts, polo shirts, long sleeved crew neck shirts, and camisole tank tops, and that many of those items include embroidered decoration. Opposer also uses that mark on shorts and other casual clothing, and in connection with retail clothing store services. Opposer's testimony and evidence also show that opposer sells its clothing nationwide through its catalogs and Internet web site, and that opposer operates its retail stores in several states, including Florida, where applicant is located.

Although the record is devoid of evidence showing clothing items actually bearing applicant's mark, the specimens in the application file reflect use on hangtags attached to embroidered shirts, pants, skirts, dresses, socks, hats and jackets. The specimens also include business cards bearing the mark which advertise applicant's embroidery services as being offered to corporate, wholesale and retail customers.

Applicant argues that his clothing articles are limited to embroidered clothing, and that this is sufficient to distinguish his clothing from that of opposer. Applicant also argues that the channels of

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trade for the parties' respective goods differ because applicant's clothing is sold for resale to middlemen or distributors, whereas opposer's clothing is sold directly to "end user" consumers through retail outlets.

In response, opposer argues that its pleaded registrations and the evidence show that its goods are essentially identical to those of applicant, and that they travel in the same channels of trade to the same consumers.

Applicant's arguments are not well taken. It is well settled that the issue of likelihood of confusion must be resolved on the basis of the goods and/or services set forth in the application and those recited in an opposer's registrations, rather than on what any evidence may show those goods and/or services to be. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, in the absence of specific limitations in the application and registrations, the comparison of the goods and/or services is made by considering the normal and usual channels of trade and methods of distribution for such identified goods or services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

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There are no relevant limitations on the types of clothing identified in opposer's pleaded Registration Nos. 1,139,644; 1,406,812; and 1,660,884, and we must therefore presume that opposer's t-shirts, shorts and sportswear tops and bottoms encompass all types of the identified clothing, including embroidered clothing such as identified in applicant's application. Further, it is presumed that the clothing moves in all normal channels of trade and that the clothing is available to all classes of purchasers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Moreover, inasmuch as opposer's identifications of goods are broad enough to include embroidered clothing (and, in point of fact, opposer's clothing does include embroidered items), we find that opposer's goods are related to applicant's embroidering services.

Based on the record, we find that applicant's clothing and his embroidery services are closely related to opposer's clothing, and that the parties' respective goods and services are offered to the same general classes of customers in the same channels of trade.

We turn next to a comparison of the parties' marks. Although we have considered the marks in their entireties, "there is nothing improper in stating that,

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for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, applicant's mark CRAZY THREADS contains the identical distinctive term CRAZY found in all of opposer's pleaded marks. In our view, the term CRAZY is arbitrary when used in connection with clothing. There is some minimal stylization in two of opposer's five pleaded marks, but these differences are not sufficient to distinguish the marks. The primary difference between the parties' marks is wording that is clearly generic or highly descriptive when used in connection with clothing, e.g., THREADS⁸ versus SHIRTS, SHORTS and SWEATS. However, a descriptive component of a mark is typically given less weight in reaching a conclusion on likelihood of confusion. *National Data*, 753 F.2d at 1060, 224 USPQ at 752. Moreover, applicant has disclaimed THREADS in its mark, and disclaimed

⁸ Although opposer requests that we take judicial notice of the dictionary definition of "threads," it failed to include a copy of such a definition with its brief. Nonetheless, we take judicial notice of the fact that one definition of "threads" is "clothes." *Random House Webster's College Dictionary* (1991). See *TBMP* § 712; *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)(dictionary definitions are appropriate subject matter for judicial notice by Board.)

matter is typically less significant in forming a mark's overall impression. Accordingly, it is the word CRAZY which plays the major role in forming the overall impressions of the parties' respective marks.

In short, we find that applicant's mark CRAZY THREADS creates a confusingly similar overall commercial impression to opposer's marks that contain the wording CRAZY SHIRTS, CRAZYSWEATS and CRAZYSHORTS.

Applicant's argument that the large number of marks containing the term CRAZY registered by third parties for clothing shows that opposer's marks are entitled to a relatively narrow scope of protection is to no avail. Applicant has not made of record any evidence of third-party uses or registrations of such marks. Instead, he has merely made a reference in his brief to incorporate a list of such marks submitted as part of his response to the Trademark Examining Attorney's first Office action during initial examination of the application. However, a party may not make third-party registrations of record simply by referring to a listing of them in its brief or pleading, nor can registrations introduced during the prosecution of an application be treated in an inter partes proceeding as evidence of the existence of such

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registrations. See *TBMP* § 703.02(b), and cases cited therein. Accordingly, we have not considered applicant's listing of such third-party marks in our determination.⁹

Lastly, we are not persuaded by applicant's argument that there have been no instances of actual confusion in the seven years applicant has been in business. There are no specifics in the record regarding the extent of use by applicant and, thus, there is no way to assess whether there has been a meaningful opportunity for confusion to occur in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.2d 943, 949, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Moreover, the test is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.

Decision: The opposition is sustained, and registration to applicant is refused.

⁹ We add, however, that it would not change our determination even if applicant had properly introduced evidence of the listed marks into the record, as those marks do not establish that the term CRAZY alone is diluted or weak as applied to clothing.